

Applicant will argue on appeal that the anticipation rejection is misguided for two reasons. First, the Chao flashing is not seamless, as required by Claim 1. See Figure 1, showing lines extending from the top ring of the flashing curb 22b down to the flange 22a, particularly on the right side of the curb near the notch in the top ring. Applicant is employed by the owner of the Chao patent and the seamless flashing feature was not conceived of by Applicant prior to making the present invention.

Second, the examiner has decided that the strengthening anomaly of Claim 6 is somewhere in the Chao patent, but has not identified where. Is the examiner perhaps confusing what are obviously surface shading lines on the flange 22a with the claimed element? These lines quite clearly are an artifact of Patent Office surface shading requirements, not structure.

Applicant will argue on appeal that the obviousness rejection does not comply with the requirements of MPEP §2142 in making a *prima facie* case of obviousness, in that no expectation of success has been shown in combining the references nor can it be. That was precisely the point of Applicant's previous argument, which the Examiner has discounted, namely, that the way the plastic cover of Hoy et al. is made - by vacuum forming - would militate against combining Hoy et al. with a metal flashing reference, because metal flashings cannot be formed by vacuum forming, to the best of Applicant's knowledge. Thus, far from arguing a method of manufacture in an attempt to patent a device claim, Applicant's argument instead is directed to showing why no reasonable expectation of success exists in combining the references as proposed by the Examiner, thus demonstrating why a *prima facie* case of obviousness has not been properly made.

Furthermore, the Examiner has stated that "it is the Examiner's position that the process of stamping a seamless metal member is a well-known expedient in the art." Applicant, who for many years has been the CEO of a leading manufacturer of skylights in the United States, is under no such misconception.

CASE NO.: 1128.006A
Serial No.: 09/376,461
October 19, 2000
Page 3

PATENT
Filed: August 18, 1999

"Examiner positions" are not allowed to substitute for prior art evidence. Accordingly, a prior art showing supporting the Examiner's position that stamping a seamless metal member is a well-known expedient in the art of skylight flashing manufacture is hereby seasonably requested under MPEP §2144.03.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,


John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg